

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/811,160
Applicant(s) : Bilskie, et al.
Filed : March 26, 2004
Title : AN APPARATUS FOR SLABBING A
: ROLL OF MATERIAL
TC/A.U. : 3724
Examiner : K. E. Peterson
Conf. No. : 1981
Docket No. : 9596
Customer No. : 27752

REPLY BRIEF UNDER 37 C.F.R. 1.193(b)(1)

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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY REMARKS

This is in response to the Examiner's Answer mailed July 21, 2009.

EXAMINER'S ANSWER

The Examiner has acknowledged the correctness of Sections 1 through 7 of Appellant's Appeal Brief.

This Reply Brief is being filed in view of Section 10, Response to Argument, in the Examiner's Answer.

THE EXAMINER'S POSITION

The Examiner's Answer on page 3 acknowledges Applicant's position that the *McCay* reference lacks an integral transport element with two engaging portions. Further, the Examiner's Answer on page 4 acknowledges that the *Pyron* reference does not disclose any detail of a transport mechanism and whether or not such a transport mechanism has any core engaging portions.

APPELLANT'S REPLY

Appellant respectfully submits that to establish *prima facie* obviousness under 35 U.S.C. §103(a), several criteria must be met. First, there must be some suggestion or motivation either in the references themselves or the knowledge generally available to one of ordinary skill in the art to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success of obtaining the claimed invention based upon references relied upon by the Examiner. Third, the prior art reference when combined must teach or suggest all the claim limitations. *See In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed.Cir. 1991). Motivation serves to prevent hindsight bias. *See Medicem, S.A. v. Pokbo, S.L.*, 432 F.3d 1157 (Fed. Cir. 2006) “Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the [claimed] invention.” *See ATD Corp. v. Lydell, Inc.*, 159 F.3d 534, 48 U.S.P.Q. 2d 1321 (Fed. Cir. 1998)

Relative to the *McCay* reference, it is abundantly clear (as Appellant has provided to the Examiner on numerous occasions) that *McCay* clearly **requires** a cantilevered core support. This is because the *McCay* reference provides a description beyond any other of a means for securing the core to the cantilevered support. This means for securing the core to the cantilevered support requires an intricate gear ring assembly that locks the core onto the

cantilevered support tube for eventual stripping of the material disposed thereon. This additional apparatus contained within the cantilevered tube is **integral and necessary** for operation of the *McCay* reference. Whether or not the Examiner references FIG. 1 or FIG. 2 of the *Esping* reference, neither figure provides, or can provide, the structure equivalent to the Appellant's claimed device and yet maintain the combinability required with that of the *McCay* disclosure. There is no teaching, suggestion, motivation, description, or other language within the four corners of the *Esping* reference that alludes to the capability to provide for the core locking mechanism within the device shown in the *Esping* reference in either FIG. 1 or FIG. 2. In other words, substitution of the *Esping* disclosure provides *McCay* as an inoperative embodiment. This leaves the *McCay* reference unable to perform the necessary function that the description says is **critical** to the performance of the apparatus.

In any regard, it appears abundantly clear that the Examiner has completely obviated the teaching, suggestion, or motivation test provided for by the Federal Circuit. It should be recalled that while failure to teach, disclose, or suggest is not completely dispositive of the issue of obviousness, it is certainly to be viewed as an element thereof.

Further, Appellant would conclude that the *Esping* reference teaches away from the intent and purpose of the core slabber described by the *McCay* reference. Again, the Examiner is completely obviating the teaching, suggestion, or motivation test provided by the Federal Circuit. No less than the BPAI has concluded that, "We recognize that 'the [obviousness] analysis' need not seek out precise teaching directed to the specific subject matter of the challenged claim, for a court can take a count of the inferences and creative steps that a person of ordinary skill in the art would employ." (Appeal 2008-1092, p. 6) (citing *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)). However, *KSR* also teaches that an invention 'composed of several elements' is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. (citing *KSR* at 1741) "There must be 'a reason' that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *Id.*

Absent any disclosure within the *Esping* reference to an apparatus to lock a core onto the assembly provided in either FIG. 1 or FIG. 2, the *Esping* reference cannot cure the defects of the *McCay* reference. Further, it appears as though the Examiner has essentially piecemealed together components present within other references in order to cobble together

a frog of an obviousness rejection. No amount of wishing in this instance can turn this frog into a prince. Nowhere within the four corners of the *McCay* reference is there any suggestion to provide an integral transport element capable of engaging the roll and of conveying the roll to a slabbing position where the transport element further comprises a pair of roll engaging elements capable of penetrating engagement of the core and locking the core thereto. It also seems highly improbable that anyone of skill in the art having the disclosure of the *McCay* reference in hand would be remotely likely to even consider the disclosure of the *Esping* reference to modify the deficiencies provided therein without the use of impermissible hindsight. “Even if all its limitations could be found in the total sets of elements combined in the prior art references, a claimed invention would not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention.” *See National Steel Car, Ltd. v. Canadian Pacific Railway, Ltd.*, 357 F.3d 1319, 69 U.S.P.Q. 2d 1641 (Fed. Cir. 2004)

Additionally, with regard to the Examiner’s minimization of Appellant’s arguments relative to the *Pyron* in view of *Pienta* with or without the *McCay* reference, Appellant again respectfully submits that the Examiner has clearly failed to set forth a *prima facie* case of obviousness in accordance with M.P.E.P. §2143. It is abundantly clear that the *Pyron* reference, or the other references cited by the Examiner, does not teach, disclose, or suggest Appellant’s pair of roll engaging elements. Again, incorporation of these disparate references cited by the Examiner in an effort to cobble together a *prima facie* case of obviousness leads to the same inevitable conclusion. The primary reference cited by the Examiner becomes inoperative with the incorporation of selectively chosen portions of the secondary references. There has been no clear articulation of how these selectively provided portions of the secondary references can be incorporated into the apparatus disclosed by the primary reference and still maintain the intended operation. Again, this clearly suggests that the Examiner is engaging in the use of improper hindsight in order to establish a *prima facie* case of obviousness. Consistent with the Supreme Court’s decision in *KSR*, merely selecting portions of references in an effort to find each and every element of Appellant’s claimed invention is not permissible. Clearly, Appellant’s invention cannot be proved obvious merely by demonstrating that each of the elements as claimed was independently known in the prior art.

Thus, the Examiner's case of *prima facie* obviousness fails. The *Pyron* reference, alone or in combination with any of the *Pienta* or *McCay* references, does not and cannot teach, disclose, or even provide a remote modicum of a suggestion for each and every element of Appellant's claimed invention.

Appellant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. The Examiner essentially asserts that Appellant is relying on particularized portions of the references as a basis for argument and ignoring the teachings of the references as a whole. Appellant disagrees. The Examiner appears to be utilizing mere speculation based upon background information related to the technology at issue as the basis for the instant rejection without any suggestion or motivation provided by the cited prior art.

Accordingly, absent any suggestion or motivation by the cited prior art or without the use of hindsight analysis, the cited references, alone or in combination, cannot render obvious Appellant's claimed invention. *See* M.P.E.P. §2143.03; *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974); *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed.Cir. 1988).

The remarks contained within this Reply Brief are an addition to the remarks contained within Appellant's Appeal Brief and Amendments contained in the present Application, which are incorporated herein by reference.

In light of the foregoing, Appellant respectfully requests the Board to reverse all rejections by the Examiner in the final rejection, as discussed above.

Respectfully submitted,
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